

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Dane K. FISHER *et al.*

Appeal No.: 2002-2046

Appln. No.: 09/619,643

Filed: July 19, 2000

Confirmation No. 2183

Art Unit: 1634

Examiner: Jeanine Anne GOLDBERG

Atty. Docket: 16517.291

For: Nucleic Acid Molecules and Other Molecules Associated with Plants

Request to Publish Opinion in Support of Board Decision as
Binding Precedent

Mail Stop 8
Director of the U.S. Patent and Trademark Office
P.O. Box 1405
Alexandria, VA 22313-1450

Sir:

Appellant hereby requests that the opinion in support of the decision of the Board of Appeals and Interferences ("Board") in the above-captioned appeal be published as binding precedent.

On April 1, 2004 the Office mailed a decision of the Board in the above-captioned appeal ("Decision") indicating that "[t]he opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board." Appellant respectfully requests that the Office publish this Decision as binding precedent.¹

¹ If the Office denies Appellant's request to publish the opinion as binding precedent, Appellant requests that the Office publish the decision as non-binding precedent.

I hereby certify that the foregoing Request to Publish Opinion in Support of Board Decision as Binding Precedent is being facsimile transmitted to the Office of the Solicitor via facsimile number (703) 872-9306 and to the attention of Dianne E. Maggard via facsimile number (703) 308-6200.


Thomas E. Holsten (Reg. No. 46,098)

May 12, 2004

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A. The Opinion of the Board Should be Published as Binding Precedent

Ex Parte Holt, 19 U.S.P.Q.2d 1211 (B.P.A.I. 1991) provides criteria for when a decision should be published as a precedential opinion.² In *Ex Parte Holt*, the Board stated that in most cases, a published decision will be one that “significantly adds to the body of law addressing a substantive legal point not specifically previously addressed by the Federal Circuit ... or informs the patent bar and examining corps how the Board is interpreting prior court or Board decisions as they relate to particular factual situations....” *Id.* at 1214. The Board also noted that opinions are generally authorized for publication where the opinion is: “(a) consistent with other decisions which have been rendered by the Board and (b) consistent with binding precedent by the Federal Circuit.” *Id.*

Appellant requests that the Office publish the Decision as binding precedent because the Decision is one that significantly adds to the body of law by addressing whether partial nucleic acid molecules, such as Expressed Sequence Tags (“ESTs”), have utility.³ To date, neither the United States Court of Appeals for the Federal Circuit (“Federal Circuit”) nor the Court of Customs and Patent Appeals (“CCPA”) has addressed the issue. Moreover, the Decision warrants publication as binding precedent as

² Internal PTO procedures for the publication of opinions as binding precedent is governed by the Board’s Standard Operating Procedure 2 (Revision 4), effective March 29, 2000, which notes that “public policy favors widespread publication of opinions.”

³ The commercial importance of ESTs is evident from the growth of a multi-million dollar industry in the United States premised on the use of ESTs. Nucleic acid molecules with EST sequences are bought and sold in the biotechnology industry, as are microarrays composed of nucleic acid molecules with EST sequences. In addition, many biotechnology companies derive significant revenue from EST technology. Such technology is often licensed through agreements that require the transfer of either the clones from which the ESTs were obtained, or the information necessary to make nucleic acid molecules with the EST sequences.

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it informs the patent bar and examining corps how the Board is interpreting prior court decisions as they relate to particular factual situations before the Board.⁴ The Decision discusses United States Supreme Court, Federal Circuit and CCPA precedent and applies that precedent to the utility of ESTs. In particular, the Board interprets the utility standard set forth by the Supreme Court in *Brenner v. Manson*, 318 U.S. 519 (1966) and its progeny from the Federal Circuit and CCPA. For example, the Decision analyzes and applies *In re Kirk*, 376 F.2d 936, 153 U.S.P.Q. 48 (C.C.P.A. 1967), *In re Ziegler*, 992 F.2d 1197, 26 U.S.P.Q.2d 1600 (Fed. Cir. 1993), *In re Jolles*, 628 F.2d 1322, 206 U.S.P.Q. 885 (C.C.P.A. 1980), *Cross v. Izuka*, 753 F.2d 1040, 224 U.S.P.Q. 739 (Fed. Cir. 1985) and *In re Brana*, 51 F.3d 1560, 34 U.S.P.Q.2d 1436 (Fed. Cir. 1995).

In addition, the Board's Decision in this appeal is consistent with at least one other decision of which the Appellant is aware.⁵ In Appeal No. 2002-0078 (Application Ser. No. 09/206,040), the Board considered the utility of EST sequences from soybean and reached a similar conclusion in that appeal. Finally, although Appellant does not agree with the Board's interpretation of the utility standard, the Decision analyzes and applies United States Supreme Court, Federal Circuit and CCPA precedent.⁶

For these reasons, Appellant respectfully requests that the Decision in the above-captioned case be published as binding precedent. Should the Commissioner require

⁴ *Ex parte Holt*, 19 U.S.P.Q.2d at 1214 (stating that "[I]n most instances, a published Board opinion will be one which ... (3) informs the patent bar and examining corps how the Board is interpreting prior court or Board decisions as they related to particular factual situations before the Board.")

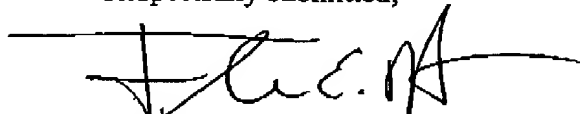
⁵ *Id.* (stating that "[G]enerally, the Board authorizes publication of its opinions only in those instances in which the opinion is (a) consistent with other decisions which have been rendered by the Board")

⁶ *Id.* (stating that "[G]enerally, the Board authorizes publication of its opinions only in those instances in which the opinion is ... (b) consistent with binding precedent by the Federal Circuit.")

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additional information, he is invited to contact the undersigned at the number provided below.

Respectfully submitted,



David R. Marsh (Reg. No. 41,408)
Holly Logue Prutz (Reg. No. 47,755)
Thomas E. Holsten (Reg. No. 46,098)

Date: May 12, 2004

Of Counsel
Lawrence M. Lavin, Jr.
(Registration No. 30,768)
Thomas E. Kelley
(Registration No. 29,938)
Correspondence Address:
MONSANTO COMPANY
800 N. Lindbergh Blvd.
Mailzone N2NB
St. Louis MO 63167
(314) 694-3602 telephone
(314) 694-1671 facsimile

ARNOLD & PORTER LLP
555 Twelfth Street, N.W.
Washington, D.C. 20004
(202) 942-5000 (phone)
(202) 942-5999 (facsimile)